

REMARKS

I. Introduction

In response to the Office Action dated September 29, 2005, claims 1, 3-11, 13-18, 20, 21, 23-28, and 30 have been amended, and claims 31-33 have been added. Claims 1-33 are in the application. Re-examination and re-consideration of the application, as amended, is requested.

II. Claim Amendments

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and were not required for purposes of patentability.

III. Office Action Objections

In paragraph 1, the Office Action objects to the drawings because no item 304 is indicated.

The Applicants thank the Examiner for noting this error, and have included herewith Proposed Drawing Changes.

In paragraph 2, the Office Action objects to claims 6, 16, and 26 because of informalities. The Applicants thank the Examiner for noting these errors and have amended the claims accordingly.

In paragraph 3, the Office Action objects to claim 30 because of informalities. The Applicants thank the Examiner for noting this error and have amended the claim accordingly.

IV. The Cited References and the Subject Invention

A. The Dorfman Reference

U.S. Patent No. 5,960,164, issued September 28, 1999 to Dorfman et al. disclose a method and system for producing documents at a first site from database information produced at a second site remote from the first site. The method and system is said to have enhanced system flexibility and enhanced data handling throughput, which are accomplished by adopting standard programming interface or database tables to allow a computer at the second site to obtain information necessary to generate all necessary data codes and stream formatting information which

will be utilized at the first site. An object association table, which associates document production jobs with specific documents and appropriate descriptions, is provided at the first site so that it is accessible--e.g. through an online communications network--at the second site. The object association table is accessed at the second site in realizing substantially only file names in the object association table, to produce database information at the second site. The database information is supplied from the second site to the first site where it is translated so that it may be utilized by a specific print engine at the first site, utilizing a job formatting table to build an engine specific print stream for one or more print engines. Then the engine specific print stream, tailored to the particular print engine utilized, electronically controls a specific print engine at the first site to image documents having variable information from the database information supplied from the second site.

B. The Shirakawa Reference

U.S. Patent No. 5,926,825, issued July 20, 1999 to Shirakawa discloses an article layout device for automatically making layout of multi-column documents. The article layout device comprises a layout execute section which virtually sets rectangular columns on an area where documents are arranged and searches for an unused sole column or compound column until the columns are filled with articles or all articles are completely arranged to attain a layout result on articles which can be arranged; an article entry priority output section which outputs the entry priority of each article to be entered, as required; a layout result evaluation section which gives an evaluation value based on the entry priority of the article to each of a plurality of layout results determined by the layout execute section; and a best layout result retrieval section which selects the layout result having the best evaluation value given by the layout result evaluation section among the plurality of layout results determined by the layout execute section.

V. Office Action Prior Art Rejections

In paragraphs (4)-(5), the Office Action rejected claims 1-7, 9-17, 19-27, and 29-30 under 35 U.S.C. § 102(b) as being anticipated over Dorfman et al., U.S. Patent No. 5,960,164 (Dorfman).

With Respect to Claims 1, 11, and 21: Claim 1 recites:

A method of printing an impositioned document, comprising the steps of:
receiving source data;
receiving a job ticket generated from the source data, the job ticket having a first identifier identifying
a resource of the document and layout information describing a layout of the resource in the document;
generating a second identifier associated with the resource, the second identifier locally recognizable by
a printing device;
storing the second identifier remotely from the printing device;
storing the resource locally to the printing device; and
printing the stored resource according to the layout information.

The Office Action argues that the second identifier and the job ticket of the Applicants invention are “embodied in” Dorfman’s “Job Formatting Table” and “Object Association Table,” respectively . Since these features are certainly not explicitly disclosed in the Dorfman reference, the Office Action appears to argue that such features are *inherent* to the Dorfman disclosure.

Inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269(Fed. Cir. 1991). Instead, to establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co.*, 948 F.2d at 1268.

Because the job tickets and identifiers of the Applicants’ claims are not required for the operation of the Dorfman system, the Applicant respectfully suggest that Office Action’s reliance on the inherency doctrine is misplaced.

Even if the application of the Inherency Doctrine was appropriate in this instance, Dorfman fails to disclose key features of the Applicants’ claimed invention. For example, the second phrase of claim 1 recites the step of:

“receiving a job ticket generated from the source data, the job ticket having a first identifier identifying a resource of the document and layout information describing a layout of the resource in the document.”

The Office Action asserts that the “first identifier ... describing a layout of the resource in the document” is “possessed” within Dorfman’s “Formatting Table.” However, Dorfman’s “Formatting Table”: (1) does not disclose anything analogous to a *job ticket*, or anything *job* related, but rather, a formatting table that *translates* database information so that it can be used by a particular print driver, (2) does not include a first identifier *identifying a resource* of the document, (3) does not include layout information describing a layout of the resource in the document. Instead, the job formatting table “map(s) variable data fields provided by a database publisher to the actual data stream read by the print system.”

Claim 1 also recites the following:

“generating a second identifier associated with the resource, the second identifier locally recognizable by a printing device”

The Office Action asserts that this second identifier is disclosed by Dorfman’s “Object Association Table.” However, given the Office Action’s arguments with regard to the first identifier, this cannot be the case.

Dorfman’s “Object Association Table” provides information allowing the second site to compute database information. Dorfman teaches that this database information is provided to the “Job Formatting Table” (discussed above) where it must be *translated before it can be used* by the print engine. Even if Dorfman’s “Object Association Table” were to disclose something akin to a second identifier, it is not one that is *locally recognizable by the printing device* ... it is one that must be *transformed* to be recognizable. Dorfman therefore teaches away from the Applicants’ invention.

Claims 11 and 21 recite analogous features and are patentable for the same reasons.

With Respect to Claim 2: Claim 2 recites that the source data is received in a print optimizer and that the second identifier is stored in the print optimizer. The Office Action argues that Dorfman’s first computer (e.g. 24) is a print optimizer because it “associates resources with parameters such as Object ID, job ID, or object code,” but the Applicants do not understand how association with resources fairly discloses a “print optimizer”.

Claims 12 and 22 recite analogous features and are patentable on the same basis.

With Respect to Claim 10: Claim 10 recites the step of associating the first identifier with variable data tag, and replacing the variable data tags with variable data or a reference to the variable data. The Office Action indicates that the association of the first identifier with the variable data is analogous to simply “specifying variable data fields”, as disclosed in Step 41 of FIG. 4. The Applicants respectfully disagree that associating *the identifier recited in claim 1* with a tag is analogous to simply specifying that a field is variable.

Claims 20 and 30 recite analogous features and are patentable for the same reasons.

In paragraphs (6)-(7), the Office Action rejected claims 8, 18, and 28 under 35 U.S.C. §103(a) as being unpatentable over Dorfman in view of Shirakawa, U.S. Patent No. 5,926,825 (Shirakawa).

With Respect to Claim 8 : Claim 8 recites the method of claim 1 including the following additional steps:

- receiving a second job ticket having the first identifier and second layout information describing a second layout of the resource in the document
- transforming the first identifier into the second identifier; and
- printing the stored resource according to the second layout information.

Dorfman, of course, does not disclose the feature of transforming the first identifier into the second identifier.

Recall that the Office Action has suggested that the Applicants’ “first identifier” is inherent to Dorfman’s “Job Formatting Table” and the Applicants’ “second identifier” is “possessed by” Dorfman’s “Object Association Table”. Modifying Dorfman to read on claim 8 would require that the engine specific print image stream (the product of the “Job Formatting Table”) be translated into the data set (the product of the “Object Association Table”). Not only is there no teaching to do this, Dorfman teaches the opposite.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference’s disclosure will teach away if it suggests that the line of development flowing from the reference’s disclosure is unlikely to be

productive of the result sought by the Applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994).

Shirakawa is of no help, as all it discloses is a means for dealing with multiple layouts. The method by which such layouts are handled bears no resemblance to the Applicants' invention or Dorfman.

Claims 18 and 28 recite analogous features and are patentable for the same reasons.

VI. Dependent Claims

Dependent claims 2-10, 12-20, and 22-30 incorporate the limitations of their related independent claims, and are therefore patentable on this basis. In addition, these claims recite novel elements even more remote from the cited references. Accordingly, the Applicants respectfully request that these claims be allowed as well.

VII. New Claims

New claims 31-33 are presented for the first time in this Amendment. Claims 31-33 recite that the second identifier is generated from the first identifier, which is plainly not disclosed or taught by Dorfman. Accordingly, new claims 31-33 are patentable over the prior art of record, and the Applicants respectfully request the allowance of these claims as well.

VIII. Conclusion

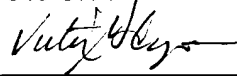
In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

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G&C 156.1-US-01

